

REMARKS

This is intended as a full and complete response to the Office Action dated December 31, 2003, having a shortened statutory period for response set to expire on March 31, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-27 are pending in the application. Claims 1-4, 6-13, 15-22 and 24-30 remain pending following entry of this response. Claims 1, 4, 10, 11, 13, 17, 19, 20, 22 and 26 have been amended. Claims 5, 14 and 23 have been cancelled. New claims 28-30 have been added to recite aspects of the invention. Applicants submit that the amendments and new claims do not introduce new matter.

Claims 1-3, 10-12, and 19-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Damerau et al.* (US 5,258,909) in view of *McRae et al.* (US 4,847,766). The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to modify the teachings of *Damerau et al.* in view of *McRae et al.* to include the limitations recited in claims 1-3, 10-12, and 19-21. Applicants traverse the rejection and respectfully submit that the cited references fail to teach, show, or suggest the limitations recited in claims 1-3, 10-12, and 19-21.

Damerau et al. discloses a method for detecting and correcting a wrong word based on the probability of occurrence of the words in a string of words. In determining a replacement word, *Damerau et al.* discloses forming a tentative word (W_T) and comparing the tentative word against a dictionary. (*Damerau et al.*, col. 6, lines 6-18). *McRae et al.* discloses a word processing system having a list of commonly-confused words and associated alternative words stored in memory.

Regarding claims 1, 10, and 19, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have saved the comparisons of the problem word and each replacement word as disclosed in *Damerau et al.* into a data structure to form a list such as that taught by *McRae et al.* Applicants traverse the rejection on grounds that the Examiner has not properly established a prima facie obviousness rejection. Applicants submit that all the claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA

1974). Contrary to Examiner's assertion, *Damerau et al.* does not make any comparison between the problem word and the replacement word. Instead, *Damerau et al.* compares a potential replacement word (i.e., tentative word W_T) against a dictionary to determine whether the potential replacement word is a valid word. Furthermore, once a replacement word has been determined in D_m , the problem word is simply replaced, and as such, the problem word and the replacement word are not stored and related in any manner. Therefore, the cited references, alone or in combination, do not teach, show or suggest storing user-replaced problem words and associated replacement word in an individual record of a data structure, as recited in claims 1, 10, and 19.

Regarding claims 3, 12 and 21, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have stored and compared the pre-edited and post-edited content to identify the problem words and replacement words because those would have been the only words different between the two document versions. Applicants traverse the rejection on grounds that the Examiner has not properly established a prima facie obviousness rejection because the cited references failed to teach or suggest all the claim limitations. As discussed above, the cited references, alone or in combination, fail to teach, show or suggest storing user-replaced problem words and associated replacement word in an individual record of a data structure, as recited in claims 1, 10, and 19. Moreover, the cited references, alone or in combination, fail to teach, show or suggest recording the pre-edited content and the post-edited content and comparing the pre-edited content to the post-edited content to identify the problem words and replacement words, as recited in claims 3, 12 and 21.

Furthermore, M.P.E.P. §2143.01 expressly states that the fact that a claimed invention might be within the capability of one of ordinary skill in the art is not sufficient to establish obviousness. See, *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) and *In re Kotzab*, 55 USPQ2d 1313, (Fed. Cir 2000). Applicant submits that an unsupported conclusion that one of ordinary skill in the art could have envisioned the claimed invention constitutes no more than impermissible hindsight reconstruction of Applicant's invention. See, *In Re Dembiczak*, 50 USPQ2d 1614 (Fed.

Cir. 1999). Therefore, Applicants submit that claims 1-3, 10-12, and 19-21 are patentable over *Damerau et al.* in view of *McRae et al.*, and reconsideration of the rejection is respectfully requested.

Claims 4, 13 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Damerau et al.* in view of *McRae et al.* as applied to claims 3, 12, and 21 above, and further in view of *Lange et al.* (US 4,674,065). The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to modify the teachings of *Damerau et al.* in view of *McRae et al.*, and further in view of *Lange et al.* to include the limitations recited in claims 4, 13 and 22. Applicants traverse the rejection and respectfully submit that the cited references fail to teach, show, or suggest the limitations recited in claims 4, 13 and 22.

Lange et al. discloses a system for detecting and correcting contextual errors in which data is entered in memory through a keyboard. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to store the pre-edited contents and the post-edited contents into a data structure as taught by *Lange et al.* Although *Lange et al.* discloses entering data through a keyboard and storing the data in memory, *Lange et al.* does not teach, show or suggest that the pre-edited contents and post-edited contents are separately stored in a data structure. Furthermore, as discussed above, the cited references, alone or in combination, fail to teach, show or suggest storing user-replaced problem words and associated replacement word in an individual record of a data structure and fail to teach, show or suggest recording the pre-edited content and the post-edited content and comparing the pre-edited content to the post-edited content to identify the problem words and replacement words. Therefore, Applicants submit that claims 4, 13 and 22 are patentable over *Damerau et al.* in view of *McRae et al.*, and further in view of *Lange et al.*, and reconsideration of the rejection is respectfully requested.

Claims 6-7, 15-16, and 24-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Damerau et al.* in view of *McRae et al.* as applied to claims 1, 10, and 19 above, and further in view of *Grover et al.* (US 5,818,437). As discussed above, the cited references, alone or in combination, fail to teach, show or suggest storing user-replaced problem words and associated replacement word in an individual record of a

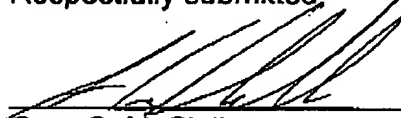
data structure. *Grover et al.* discloses a system for entering ambiguous text using a reduced keyboard and processing the ambiguous text to produce a selection of words for user selection. The words for user selection are displayed in order according to some particular criteria, such as frequency of use, and every word is given a value for such determination. However, Gv does not teach, show or suggest assigning a value to a problem word, and particularly, in relation to a respective replacement word. Therefore, Applicants submit that claims 6-7, 15-16, and 24-25 are patentable over *Damerau et al.* in view of *McRae et al.*, and further in view of *Grover et al.*, and reconsideration of the rejection is respectfully requested.

Claims 8-9, 17-18, and 26-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Damerau et al.* in view of *McRae et al.* as applied to claims 1, 10, and 19 above, and further in view of *Cai et al.* (US 6,175,834 B1). As discussed above, the cited references, alone or in combination, fail to teach, show or suggest storing user-replaced problem words and associated replacement word in an individual record of a data structure. Therefore, Applicants submit that claims 8-9, 17-18, and 26-27 are patentable over *Damerau et al.* in view of *McRae et al.*, and further in view of *Cai et al.*, and reconsideration of the rejection is respectfully requested.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted



Gero G. McClellan

Registration No. 44,227

MOSER, PATTERSON & SHERIDAN, L.L.P.

3040 Post Oak Blvd. Suite 1500

Houston, TX 77056

Telephone: (713) 623-4844

Facsimile: (713) 623-4846

Attorney for Applicant(s)